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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,563	07/16/2003	Satoshi Kidooka	P23565	7116

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GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER
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PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

NOTIFICATION DATE	DELIVERY MODE
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05/23/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

## Office Action Summary

Application No.

10/619,563

Applicant(s)

KIDOOKA, SATOSHI

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-9,12-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-9,12-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Applicant's amendment and comments, received April 3, 2007, have been fully considered by the examiner. The following is a complete response to the April 3, 2007 communication.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

Claims 1-3, 5, 7-9, 12-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi (2002/0123667) in view of Rydell (5,035,696) and further in view of the teachings of Rydell (5,258,006) and Webster, Jr. et al (5,827,278).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Ouchi discloses a bipolar treatment tool for an endoscope substantially as set forth in the instant application claims. It includes a flexible insulating tube (102) made of PTFE (col. 3, line 13), an end effector (110,112) attached to the end of the tube and a pair of conductive wires (122,124) extending through the tube and coupled to the end effector to provide bipolar energy to the individual jaws. The examiner maintains that the use of any well known insulating material, including a silicone resin, for making the flexible tube is deemed an obvious design consideration for one of ordinary skill in the art. Slater et al also disclose a proximal operating portion (Figure 1) for actuating the pair of conductive wires to operate the end effector. The only features not taught by Ouchi is the provision of two generally circular channels in the insulating tube through

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which the wires are individually passed. Rather, Ouchi provides a single channel and passes both wires through the single channel, each wire provided with its own individual insulation sheath.

Rydell ('696) also discloses a flexible, bipolar tool for an endoscope. In particular, Rydell ('696) teaches that the two conductive wires (24,26) may be individually insulated and passed through a lumen in the flexible insulating tube (see Figure 1). Alternatively, Rydell ('696) also teaches that the wires may be uninsulated and the flexible insulating sheath may be provided with two channels for housing the wires individually and obviate the need for an insulation coating on the wires (see Figure 5 and col. 5, lines 10-19). Rydell ('696) disclose semicircular lumens through which the wires pass, and fail to disclose the relative size between the lumen and the leads.

Rydell ('006) discloses the use of circular lumens (23) for passing individual leads (13) through an endoscopic device. Rydell ('006) fail disclose the particular size relationship between the leads (13) and the lumens (23). Figure 3 appears to show a substantial difference in the size; however, it is noted that Figures cannot be relied on for determining the scale of elements in the drawings.

With regard to the size and spacing of the lumens, the examiner again maintains that the relative size and spacing would be obvious design considerations for one of ordinary skill in the art. While applicant has indicated that there is a reason for the relative sizing (i.e. to prevent buckling of the leads), this reason is deemed to be obvious to those of ordinary skill in the art. More particularly, there is no unexpected result associated with the relative sizing. Further, the examiner now cites the Webster,

Jr. et al reference which discloses that it is advantageous to provide a sliding wire within a lumen just marginally bigger than the wire (col. 4, lines 1-15). Such an arrangement prevents buckling of the wire as it is advanced and retracted during actuation (i.e. steering) of the distal end of the catheter.

To have provided the Ouchi flexible tube with two channels for providing the individual conductive wires and obviating the need for insulation coatings on the individual wires would have been an obvious alternative arrangement for one of ordinary skill in the art, particularly since Rydell ('696) teaches that providing two channels in an insulating tube is a known alternative to insulated wires being passed through a single lumen in an insulating tube. To have further provided the two channels as two circular lumens to more fittingly receive the leads would have been an obvious design consideration for one of ordinary skill in the art in view of the Rydell ('006) patent which teaches that such alternative lumen shapes are generally well known and obvious alternatives. Finally, Webster, Jr et al fairly teach that it is known to use guide tubes that are slightly larger in diameter to facilitate the sliding of wires which would prevent buckling, and providing the Ouchi device, as modified by the Rydell references, with such a relationship would have been an obvious consideration for one of ordinary skill in the art.

Claims 1-3, 5, 7, 12-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al (5,482,054) in view of Rydell (5,035,696) and further in view of the teachings of Rydell (5,258,006) and Webster, Jr. et al (5,827,278).

Slater et al discloses a bipolar treatment tool for an endoscope substantially as set forth in the instant application claims. It includes a flexible insulating tube (50,300) made of poly-ethylene (col. 5, line 42), an end effector (18) attached to the end of the tube and a pair of conductive wires (60) extending through the tube and coupled to the end effector to provide bipolar energy to the individual jaws. The examiner maintains that the use of any well known insulating material, including a silicone resin, for making the flexible tube is deemed an obvious design consideration for one of ordinary skill in the art. The only feature not taught by Slater et al is the provision of two generally circular channels in the insulating tube through which the wires are individually passed. Rather, Slater et al provide a single channel and passes both wires through the single channel, each wire provided with its own individual insulation sheath.

Rydell ('696) also discloses a flexible, bipolar tool for an endoscope. In particular, Rydell ('696) teaches that the two conductive wires (24,26) may be individually insulated and passed through a lumen in the flexible insulating tube (see Figure 1). Alternatively, Rydell ('696) also teaches that the wires may be uninsulated and the flexible insulating sheath may be provided with two channels for housing the wires individually and obviate the need for an insulation coating on the wires (see Figure 5 and col. 5, lines 10-19). The Rydell ('696) lumens are semi-circular in shape. The examiner maintains that the use of any shaped lumen in a catheter device would be an obvious design consideration for one of ordinary skill in the art.

Rydell ('006) discloses the use of circular lumens (23) for passing individual leads (13) through an endoscopic device. Rydell ('006) fail disclose the particular size

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relationship between the leads (13) and the lumens (23). Figure 3 appears to show a substantial difference in the size; however, it is noted that Figures cannot be relied on for determining the scale of elements in the drawings.

With regard to the size and spacing of the lumens, the examiner again maintains that the relative size and spacing would be obvious design considerations for one of ordinary skill in the art. While applicant has indicated that there is a reason for the relative sizing (i.e. to prevent buckling of the leads), this reason is deemed to be obvious to those of ordinary skill in the art. More particularly, there is no unexpected result associated with the relative sizing. Further, the examiner now cites the Webster, Jr. et al reference which discloses that it is advantageous to provide a sliding wire within a lumen just marginally bigger than the wire (col. 4, lines 1-15). Such an arrangement prevents buckling of the wire as it is advanced and retracted during actuation (i.e. steering) of the distal end of the catheter.

To have provided the Slater et al flexible tube with two channels for providing the individual conductive wires and obviating the need for insulation coatings on the individual wires would have been an obvious alternative arrangement for one of ordinary skill in the art, particularly since Rydell ('696) teaches that providing two channels in an insulating tube is a known alternative to insulated wires being passed through a single lumen in an insulating tube. To have further provided the two channels as two circular lumens to more fittingly receive the leads would have been an obvious design consideration for one of ordinary skill in the art in view of the Rydell ('006) patent which teaches that such alternative lumen shapes are generally well known and obvious

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alternatives. Finally, Webster, Jr et al fairly teach that it is known to use guide tubes that are slightly larger in diameter to facilitate the sliding of wires which would prevent buckling, and providing the Slater et al device, as modified by the Rydell references, with such a relationship would have been an obvious consideration for one of ordinary skill in the art.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al (5,482,054), Rydell (5,035,696), Rydell (5,258,006) and Webster, Jr et al (5,827,278) as applied to the above claims, and further in view of the teaching of Sutton et al (5,762,613).

Slater et al provides a clevis attachment at the distal end of the device to operate the jaws, but fails to specifically disclose a pair of pins, each pin supporting a separate jaw as recited in claims 8 and 9. Rather, Slater et al provides a single insulative pin (28) upon which both jaws are connected.

Sutton et al disclose a similar device that includes a flexible tubular member (22) with a pair of control wires extending therethrough and connected to jaws (80,81) of an end effector. In particular, Sutton et al teach that the distal end of the device may include a clevis having two separate pins (72,73) with each jaw member connected to a separate pin to allow individual actuation of the jaw members.

To have provided the Slater et al device, as modified by the prior art teachings, with a dual pin clevis construction to allow for the individual actuation of the jaw



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members would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Sutton et al (5,762,613).

### ***Response to Arguments***

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

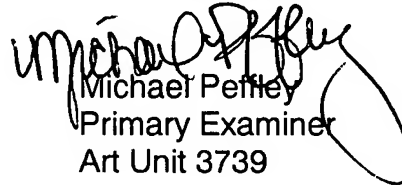
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Michael Penney  
Primary Examiner  
Art Unit 3739

mp  
May 4, 2007